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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/517,291

09/09/2005

Taketoshi Toyama

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EXAMINER

WIESE, NOAH S

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

11/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/517,291</p>	<p>Applicant(s) TOYAMA ET AL.</p>	
	<p>Examiner NOAH S. WIESE</p>	<p>Art Unit 1793</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 October 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 2,3,5,11-15.
Claim(s) withdrawn from consideration: 6-10.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Karl E Group/
Primary Examiner, Art Unit 1793

The additional limitation of new claim 16 stating that the molecular weight of the copolymer in the emulsion is more than ten times greater than that of the binder would require new search and consideration of the prior art because this limitation does not appear in the previously filed versions of the claims and thus could not have been previously considered. Consideration of this newly added limitation would clearly be necessary for determining patentability.

Applicant argues that Morley does not provide motivation to use the zinc-based flux in place of the potassium flux in the Hasegawa composition. However, as discussed in the first office action, the use of K-Zn-F flux in place of K-Al-F flux would have been an obvious substitution given their similarities and the similarities of the brazing compositions into which they are incorporated. Thus, routine optimization of the similar brazing compositions would lead one of ordinary skill to use the K-Zn-F flux of Morley in the Hasegawa brazing composition. Therefore, this argument is not persuasive.

Applicant further argues that one would not have been motivated to use (meth)acrylic acid / (meth)acrylic copolymer emulsion as a precipitation inhibitor based on Conn et al. However, as discussed in the previous office action, the motivation to use this emulsion comes from modifying Hasegawa in view of both Conn and Harakawa. Conn shows that flux compositions often benefit from the inclusion of precipitation inhibitors and Harakawa shows that (meth)acrylic acid / (meth)acrylic copolymer emulsion can be used as precipitation inhibitors. Because Hasegawa teaches that a (meth)acrylic acid / (meth)acrylic copolymer is used in the brazing compositions, one would have been motivated to use this type of polymer (with the different molecular weight taught by Harakawa) as a precipitation inhibitor as well. Thus applicant's arguments that Conn would not motivate one to use this type of inhibitor and that Harakawa does not teach an equivalent composition are not persuasive because they fail to interpret the rejection grounds as issued, which state that both references together provide motivation for the modification.

For the above reasons, applicant's arguments are not persuasive and the amendments are not entered because they would necessitate a new search and consideration.